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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/558,388	11/29/2005	Tadashi Hiramoto	040894-7353	5709
9629 7590 10/29/2009 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER MEHTA, HONG T	
			ART UNIT 1794	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/558,388

Applicant(s)

HIRAMOTO ET AL.

Examiner

HONG MEHTA

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/IB)
Paper No(s)/Mail Date August 31, 2009 and June 29, 2009.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to applicant's remarks filed on June 18, 2009. Pending new claims 32-47 are under examination. Claims 1-31 are cancelled.

Claim Objections

1. Claims 32-43 are objected to because of the following informalities: ***Camellian sinesis*** is misspelled for the species ***Camellia sinensis***. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 32-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Seltzer et al. (US 2,927,860).**
4. **Regarding claims 32-43,** Seltzer et al. discloses a tea concentrated extract (col. 3, lines 36-37) and tea aroma concentrate (col. 3, lines 58-61) obtained from black tea, green teas, and oolong teas or mixture thereof, (col. 1, lines 55-62) which are tea plant varieties of species *Camellia sinensis*. Seltzer et al. discloses tea extract is obtained with tea leaves and hot water (col. 1, lines 63-66) thus creating slurry with multiple water contacts, in the batch or continuous counter current procedures (col. 5, example 1).
5. The process of obtaining *Camellia sinensis* tea leaf powder is not a positive recitation in the claim given the use of the phrase "obtainable". "[E]ven though the

product-by-process claims are limited by and defined by the process, determination of the patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product in the product-by-process claim is the same as obvious from the product of the prior art, the claim is unpatentable even though the prior product was made by a different process." (In re Thorpe, 227 USPQ 964,966). The manner in which the powder is made is not considered to affect the final product of the tea powder or tea slurry.

6. **Regarding claims 44 and 45**, Seltzer et al. discloses a mixture of aroma concentrate and concentrated extract may be used to produce tea beverages having superior aroma (col. 4, lines 8-10).

7. **Claims 32-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Zameitat et al. (US 3,438,785).**

8. **Regarding claims 32-43**, Zameitat et al. discloses a soluble tea powder from freshly plucked green tea leaves (col. 7, lines 39-40) in the process with tea leaves and water to from a slurry to obtain a resulting tea extract (col. 7, lines 70-71) and tea aroma (col. 7, lines 25-35). Additionally, Zameitat et al. discusses the processing of green tea leaves, which is tea plant variety of species *Camellia sinensis*, including plucking fresh green tea leaves, withering at the processing plant, and physically damaging by rolling with Rotovane machines, fermenting approximately for 1 1/4 hours (col. 7, lines 45-62).

9. The process of *Camellia sinensis* tea leaf powder is not positively recitation in the claim. "[E]ven though the product-by-process claims are limited by and defined by the process, determination of the patentability is based on the product itself. The

patentability of a product does not depend on its method of production. If the product in the product in the product-by-process claim is the same as obvious from the product of the prior art, the claim is unpatentable even though the prior product was made by a different process." (In re Thorpe, 227 USPQ 964,966). Additionally, the method of Zameitat bears similarity to that of the instant claims in that the tea leaves are physically damaged, processed, and fermented. Absent a showing otherwise, the final product of the tea powder of the prior art is not considered to be structurally different from that of the claims.

10. **Regarding claims 44 and 45**, Zameitat et al. discloses tea beverage is made from the soluble tea powder (col. 8, lines 5-6) comprising tea extract and tea aroma.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. **Claims 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seltzer et al. (US 2,927,860) or Zameitat et al. (US 3,438,785) as applied to claims 32-43 above, and further in view of McCook et al. (US 5,306,486 A).**

15. Seltzer et al. and Zameitat et al. disclose the claimed invention as discussed above. Seltzer et al. discloses the mixture of the tea concentrate and tea aroma may be spray dried into dry powder ('860, col. 4, lines 11-16). Additionally, Zameitat et al. discloses the tea extract ('785, col. 70-71) and tea aroma ('785, col. 25-35) may be spray dried into dry powder ('785, col. 50-51).

16. Both, Seltzer et al. and Zameitat et al. fail to disclose a cosmetic comprising the tea extract and tea aroma with aroma or extracts of vegetable, fruit or flower.

17. However, McCook et al. discloses the combination of green tea concentrate obtained from green leaves and water, followed by spray drying to obtain a green tea concentrate powder ('486, col. 2, lines 50-54) to be formulated into a sunscreen lotion ('486, col. 2, lines 19-27, 60-62). McCook et al. discloses the formulation further

comprising extracts and aroma from avocado oil ('486, col. 4, line 28), which is a considered a fruit and sunflower oil ('486, col. 4, line 27) which is considered a flower plant.

18. It would have been obvious to one skilled in the art to combine Seltzer's tea powder or Zameitat's tea powder with McCook's cosmetic formulation of tea sunscreen lotion. McCook's combination of green tea and sunscreen lotion compound can provide better ultraviolet radiation protection than either substance separately ('486, col. 2, lines 31-44). It would have been obvious to one of ordinary skilled in the art to combine Seltzer's or Zameitat's tea powder with its' anti-oxidative and inactivation of free radicals properties with McCook's sunscreen lotion provide a more effective sunscreen system.

Response to Arguments

19. Applicant's arguments with respect to claims 32-47 have been considered but are moot in view of the new ground(s) of rejection.

20. The declaration filed on June 18, 2009 under 37 CFR 1.132 has been considered. The claims are not limited to enzymatic treatment as discussed in prior references and it is not clear if the enzyme β -D-glucopyranosides are commensurate with the claims since the enzymes used are not disclosed in the instant claims. Furthermore, it is well known in the art to collect tea leaves within different stages of first to fourth harvested flushes would result in different characteristics and quality of tea product.

21. In response to Table A within the instant specification, applicant directs the attention to key compounds F and G in the present invention. However these compounds are not commensurate in scope with the instant claims.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **HONG MEHTA** whose telephone number is (571)270-7093. The examiner can normally be reached on Monday thru Thursday, from 7:30 am to 4:30 pm EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Htm

/JENNIFER MCNEIL/

Supervisory Patent Examiner, Art Unit 1794